

Claim 32 is objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner notes that the R1 in the polymer has already been defined in claim 21.

Applicants respectfully disagree with the Examiner. In claim 21 R1 is defined as:

COOM wherein M is:

- (1) a substituted or unsubstituted C<sub>1-30</sub> straight or branched chain alkyl where the substitutents are halogen, hydroxy, or alkoxy; pyrrolidone; or
- (2) a substituted or unsubstituted aromatic, cyclic, alicyclic, or bicyclic ring where the substitutents are C<sub>1-30</sub> straight or branched alkyl.

In claim 32, which depends from claim 21, the definition of R1 is narrowed so that it includes (1) only. Accordingly claim 32 does further limit the subject matter of a previous claim.

The Examiner is respectfully requested to withdraw the objection to claim 32.

The Rejection Under 35 USC 102

Claims 21-24, 30 and 39-40 are rejected under 35 USC 102(e) as anticipated by Schehlmann. The Examiner contends that Schehlmann teaches a lipstick comprising oil, e.g. castor oil, particulate, e.g. microcrystalline wax, and polymethylacrylate, and refers to Example 34 in Column 11.

Applicants note that Schehlmann's U.S. filing date was June 26, 1997 and Applicants' earliest priority U.S. filing date was August 27, 1997. Further, Applicants are able to show that they reduced the claimed invention to practice by at least December 5, 1995, which is well before the June 26, 1997 effective date of Schehlmann. Applicants submit the Declaration of Ann Ureneck which shows that the

claimed invention was reduced to practice on December 5, 1995 well prior to the effective date of Schehlmann, and thus the latter is not a reference.

The Rejection Under 35 USC 103

Claims 21-40 are rejected under 35 USC 103(c) as unpatentable over Castrogiovanni (U.S. 5,505,937), in view of Schehlmann (U.S. 6,132,705) and Kumar (U.S. 5,468,477). The Examiner concludes that it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the claimed invention was made to modify the lipstick composition of Castrogiovanni by adding methacrylate polymers.

Applicants respectfully disagree. For the reasons discussed above, Schehlmann is not a reference against the pending claims. Castrogiovanni issued April 9, 1996 based upon an application filed December 15, 1992. Castrogiovanni is assigned to Revlon Consumer Products Corporation, the same entity to which the above captioned application is assigned and both applications were commonly owned at the time the invention was made. Further, the claimed application was filed January 22, 2001 and based upon a parent application filed August 27, 1997, with the most recent filing date after November 29, 1999. Accordingly, it is Applicants' position that Castrogiovanni can be disqualified as prior art under 35 USC 103(c) and it the Examiner is respectfully requested to do so. Pursuant to the notice in 1241 Official Gazette Patent Office 96 (December 26, 2000) summarizing the modified policy with respect to submitting evidence of common ownership or an obligation of assignment to the same person, Applicants' representative's statement on the record that the captioned application and Castrogiovanni were commonly owned at the time the invention was made is sufficient. That leaves claims 21-40 rejected over Kumar. Kumar teaches vinyl silicone copolymers containing

acrylate or methacrylate portions and silicone portions. Kumar teaches that the claimed polymers must be copolymers of silicone and various ethylenically unsaturated monomers in order to achieve the desired beneficial effects. In Kumar's lengthy "Background of the Invention" section he discusses many prior art patents and publications, including those which teach polymers that are not copolymers of silicone and acrylates and the drawbacks of those polymers. In Column 3, lines 28-49, Kumar discusses Suzuki, U.S. Patent No. 5,061,481, which teaches acryl-silicone graft copolymers and their use in cosmetic compositions. Kumar states that one of the drawbacks of the Suzuki polymers is that they are prepared by free radical polymerization of methacrylate monomers with a monomethacrylate terminated polydiorganosiloxane which provides a polymer which has a methacrylate backbone with polydiorganosiloxane chains grafted to it. Because polydiorganosiloxanes are generally of high molecular weight, they do not react completely causing the Suzuki polymers to contain significant amounts of unreacted organosiloxane which are incompatible with the silicone free (acrylate) polymer. This provides compatibility problems in the cosmetic as the acrylate portion of the polymer is not soluble in silicones. Thus it would seem that the point of making a copolymer of silicone and acrylate moieties, according to Suzuki, was to provide a polymer that was compatible in more cosmetic ingredients – it is the silicone portion of the copolymer that provides the enhanced solubility and compatibility, particular in silicone based cosmetics. For that reason Kumar teaches away from the claimed compositions. Any polymer that does not contain silicone moieties, particularly an acrylate copolymer, is not optimally functional in cosmetic systems, according to Kumar. Kumar's improvement over the prior art (Suzuki) was to make such a copolymer using a different method that ensured that all of the silicone was polymerized with the acrylate to yield copolymers where no free

silicone or acrylate was present. For the reasons set forth herein it is Applicants' position that the pending claims are not unpatentable over Kumar, Castrogiovanni, and Shehlmann.

The Examiner also specifically rejects claim 25 over Kumar, stating that it teaches that isobornyl methacrylate and methyl methacrylate are examples of polymers that can be polymerized, and refers to Column 15 line 10 through Column 16, line 11. Applicants respectfully disagree. This portion of Kumar teaches the various types of monomers that can be polymerized with the silicone to result in Kumar's silicone acrylate copolymers. Kumar does not teach polymerization of these monomers in the absence of silicone. Rather, Kumar teaches that these monomers can be selected for polymerization with silicone in order to achieve a polymer with the desired effects. As mentioned before, Kumar teaches the deficiencies of silicone acrylate polymers where the silicone and acrylate portions are not adequately polymerized. He teaches that this provides polymers with less than optimal properties which are due, in part, to the incompatibility between silicones and acrylates in cosmetic systems. Therefore, Kumar teaches away from Applicants' methacrylate polymer because it is a polymer that contains no silicone moieties yet functions perfectly well in cosmetic systems.

Claims 21-40 are also rejected under 35 USC 103(c) as unpatentable over Castrogiovanni, Kumar, and Tanabe. The Examiner concludes that it would have been *prima facie* obvious to one of ordinary skill in the art to modify the lipstick of Castrogiovanni by adding methacrylate copolymers.

Applicants respectfully disagree. Castrogiovanni is disqualified as prior art as previously noted. Kumar teaches silicone acrylate copolymers and for the reasons discussed above, does not render the claims obvious. Tanabe also teaches silicone acrylate copolymers obtained by polymerizing silicone and an acrylate or methacrylate. Tanabe teaches that these copolymers may be used in cosmetic

compositions either alone or in combination with a synthetic resin emulsion (such as a polymethyl methacrylate emulsion). For the same reasons as enumerated with respect to Kumar, it is Applicants' position that the claimed compositions are not obvious over Tanabe, either alone or in combination with Kumar. While Tanabe does not say what the polymethylmethacrylate is emulsified in, it is probably water as the term "emulsion" is usually used to refer to emulsion of water and some other material insoluble in the water, in this case an emulsion of water and a water insoluble polymethylmethacrylate. Nor does Tanabe teach any specifics as to the compositions he suggests that this polymer mixture can be used in—lipstick, eyeliner, mascara, liquid foundation, etc. Nor does Tanabe teach that the polymethylmethacrylate present in the "emulsion" have a glass transition temperature specifically within Applicants' range which is 76 to 120° C, or that oil is present therein (both limitations in Applicants' pending claims). In short, Tanabe is nothing more than a general disclosure that a polymethylmethacrylate emulsion can be used to make lipstick, foundation, mascara, eyeliner, etc. when used in conjunction with a certain silicone acrylate copolymer. Tanabe does not teach or suggest that the glass transition temperature of the polymer must be within a certain specific range, or used in a cosmetic composition with an oil and particulate matter component. There is simply nothing in Tanabe or Kumar that teaches that any advantage would be derived from combining their teachings to arrive at Applicants' claimed invention.

The Examiner also rejects claim 25 in view of Tanabe and Kumar, alleging that Kumar teaches that isobornyl methacrylate and methyl methacrylate are similarly useful for polymerization with silicone to achieve Kumar's silicone/acrylate copolymers. Applicants disagree with this conclusion as well. There is simply nothing in either reference that teaches or suggests that any advantage could be

desired from using isobornyl methacrylate in a cosmetic composition. Kumar teaches that a wide variety of monomers including isobornyl methacrylate and methylmethacrylate can be polymerized with silicone to arrive at suitable silicone acrylate copolymers, but teaches away from using polymers where the silicone and acrylate moieties are not completely polymerized. This is in essence a teaching that acrylate copolymers alone are not compatible with cosmetic systems, particularly those containing silicones. That would lead the skilled artisan to conclude that Applicants' claimed polymers were not optimal, and should not be used, in cosmetics.

The Examiner is respectfully requested to reconsider the rejection of the claims under 35 USC 103.

Respectfully Submitted,



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